

Initially, Applicant and Applicant's representative wish to thank Examiner Grant, II for the interview granted on April 5, 2001. During that interview, the outstanding rejection was discussed in detail. Further, during that interview Applicant's representative presented arguments to Examiner Grant, II that Claims 12-47 of the present Reissue application did not improperly try to recapture claimed subject matter deliberately canceled in the parent of the present application. Examiner Grant, II indicated that he would further consider that issue when a response traversing that issue is formerly presented.

Addressing now the rejection of Claims 12-47 under 35 U.S.C. §251, it is respectfully submitted that Claims 12-47 do not improperly recapture deliberately canceled claim subject matter.

It is well established that a reissue application will not be granted to "recapture" claimed subject matter deliberately canceled in an application to obtain a patent. However, it is not the situation in the present application that newly submitted Claims 12-47 of the reissue application capture previously deliberately canceled claim subject matter.

As stated in MPEP §1412.02:

Impermissible recapture occurs in a reissue where the claims in the reissue are of the same scope as, or are broader in scope than, claims deliberately canceled in an application to obtain a patent. Where such claims also include some narrowing limitation not present in the claims deliberately canceled in the application, the examiner must determine whether that narrowing limitation has a material aspect to it. *If the narrowing limitation has a material aspect to it, then there is no recapture. However, if the narrowing limitation is incidental, mere verbiage, or would be inherent even if not recited (in view of the specification), then the claims should be rejected under 35 U.S.C. 251 using form paragraph 14.17. (Emphasis added).*

New Claims 12-47 recite significant limitations which were never presented in the parent of the present application. The subject matter recited in new Claims 12-47 is directed to the embodiment such as shown for example in Figure 23 in the present specification and as

is discussed in column 25, lines 1-9. As is discussed in that portion of the specification, in one embodiment of the present invention as shown in Figure 23 a first electric power supply section 103 in the scanner module 100 is eliminated (see with respect to the embodiment of Figure 1) and power to the scanner module 100 is supplied through a cable from the electric power supply section 203a in the printer module 200. With such a configuration the number of parts in the entire system can be reduced as a power supply section is no longer needed in the scanner module. Thus, in that embodiment of the present invention the printer module includes the power supply for the scanner module. Such subject matter is being further pursued in new Claims 12-47.

Specifically, Claims 12-29 recite that the printer module includes "a power supply having an input and an output" and the scanner module includes "a power input for connection to the output of the power supply to the printer module". Thus, in the present invention as recited in Claims 12-29 the printer module includes a power supply and the scanner module only includes an input to connect to the power supply of the printer module. Such limitations as recited in Claims 12-29 are new limitations set forth in those claims which narrow the scope of Claims 12-29 with respect to original Claims 1-11. Further, it is respectfully submitted that such features as discussed above as recited in new Claims 12-29 are narrowing limitations with material aspects thereto, and that thus there is no recapture with respect to those claims.

Further, Claims 30-47 also recite at least similar limitations. More specifically, new independent Claim 30, and Claims 31-47 dependent therefrom, recite that the printer module includes "means for supplying power having an input means for inputting and an output means for outputting" and that the scanner module includes "power input means for inputting power to the scanner module from the means for supplying power of the printer module and

for connection to the output means of the power supply of the printer module". Similarly as discussed above with respect to Claims 12-29, such limitations as recited in new Claims 30-47 are also directed to narrowing limitations of those claims which have a material aspect and which are not merely "incidental", "mere verbiage", or "inherent".

In such ways, the above-noted limitations in Claims 12-47 do have a material aspect to them as they further define the structure of both the printer and scanner module. That is, such claim limitations are not "incidental", "mere verbiage", and would not be "inherent" to the original claims. As such, based on the guidelines provided in MPEP §1412.02 noted above, such limitations in Claims 12-47 overcome a rejection under 35 U.S.C. §251.

The basis for the outstanding rejection also cites the holding in *In re Clement*, 45 USPQ2d 1161 (Fed. Cir. 1997), as supporting the outstanding rejection. However, it is noted that the situation addressed in *In re Clement* is not the same situation as in the present invention. It is significant to note that in the holding in *In re Clement* an example was given of a situation in which reissue claims were broader in some aspects and narrower in other aspects than amended claims, and the Court addressed a situation that a reissue claim in question was as broad as or broader in an aspect germane to a patent rejection, but narrower in another aspect completely unrelated to the rejection, i.e. situation 3a) noted in *In re Clement* and as noted in the outstanding Office Action. That situation was addressed in *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993). In that case, the Court noted that the reissue claims in question eliminated limitations inserted into the claims during prosecution of the claims, but added additional limitations of a cylindrical member being "flexible" which formed a "single" roll. In that case, the Court held that the additional limitations of the cylindrical member being "flexible" and a "single roll" did not allow those claims to escape the recapture rule because those limitations did not

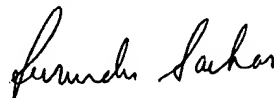
"*materially narrow* the claim[s]" (emphasis added). Again, that is contrary to the case in the present application in which the additional limitations of the "power supply" in the "printer module" providing power to the "scanner module" in Claims 12-47 do materially narrow the claims.

In such ways, it is respectfully submitted that Claims 12-47 presented in the present reissue application are proper and do not recapture subject matter canceled in the parent of the present application. Thus, it is respectfully submitted that the rejection of Claims 12-47 under 35 U.S.C. §251 has been traversed.

As no other issues are pending in this application, it is respectfully submitted that the present application is now in condition for allowance, and it is hereby respectfully requested that this case be passed to issue.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Registration No. 25,599
Attorney of Record
Surinder Sachar
Registration No. 34,423



22850

(703) 413-3000
Fax #: (703)413-2220
GJM:SNS/smi

I:\atty\SNS\05574442.am